

REMARKS

Applicants propose to amend claims 1-3 to more appropriately define the claimed subject matter. Claims 1-3, 5, and 6 are pending in this application.

Objections to Claims 1-3, 5, and 6

The Examiner objected to claim 1, at line 2, on the ground that "it appears that 'the quantities of the bone, the water and/or the muscles of the body' should simply be -- quantities of bone, water and/or muscles of the body--" (Office Action, page 2, paragraph 2).

The Examiner also objected to claim 1, at line 4, on the ground that "it appears that 'a plurality of electrodes in contact to the surface of the body' should be --a plurality of electrodes adapted to contact the surface of the body--" (Office Action, page 2, paragraph 2).

Furthermore, the Examiner objected to claim 1, at line 13, on the ground that "which' should be specifically refer [sic] to the somatotypes" (Office Action, page 2, paragraph 2).

In addition, the Examiner objected to claim 2, at line 3, on the ground that "it appears that 'include' should be --includes--" (Office Action, page 2, paragraph 2).

Claims 1 and 2 are proposed to be amended. The amendments of claims 1 and 2 are believed to obviate the Examiner's objections to claims 1-3, 5, and 6.

§ 112, Second Paragraph, Rejection of Claims 1-3, 5, and 6

Applicants respectfully traverse the rejection of claims 1-3, 5, and 6 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3, 5, and 6 are definite because one of ordinary skill in the art would understand the scope of the subject matter that is claimed when the claim is read in conjunction with the rest of the Specification. “If the claims when read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, §112 demands no more.” *S3, Inc. v. Nvidia Corp.*, 259 F.3d 1364, 1367, 59 USPQ2d 1745, 1746-47 (Fed. Cir. 2001) (quoting *Miles Laboratories, Inc. v. Shandon*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993)). “Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.”

MPEP 2173.04.

In reference to claim 1, at line 7, the Examiner alleged, “the phrase ‘such as’ renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention” (Office Action, page 3, paragraph 2).

In reference to claim 1, at lines 10-11, the Examiner alleged, “[i]t is unclear if the claim requires an approximate value for bone weight, an approximate value for water weight and an approximate value for muscular weight or if the claim only requires

calculating one of these approximate values" (Office Action, page 3, paragraph 3). The Examiner also stated, "[c]laim 1, line 2 should also be clarified since 'and/or' is stated. Claim 1, line 14 should also be clarified since 'the approximate values' is stated" (Office Action, page 3, paragraph 3).

In reference to claim 1, at line 14, the Examiner alleged, "the correlations' appears to lack proper antecedent basis in the claim" (Office Action, page 3, paragraph 4).

In reference to claim 3, at line 5, the Examiner alleged, "it is unclear to which previous limitation 'and said personal information' is related" (Office Action, page 3, paragraph 5).

In reference to claim 3, at the last line, the Examiner alleged, "the data' appears to lack proper antecedent basis in the claim" (Office Action, page 3, paragraph 6).

Claims 1 and 3 are proposed to be amended. The amendments of claims 1 and 3 overcome the Examiner's grounds for rejection under § 112, second paragraph, of claims 1-3, 5, and 6. Thus, this rejection should be withdrawn.

§ 103(a) Rejection of Claims 1-3, 5, and 6 over Shimomura and Petrucci et al.

Applicants respectfully traverse the rejection of claims 1-3, 5, and 6 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,539,310 to Shimomura ("Shimomura") in view of U.S. Patent No. 6,292,690 to Petrucci et al. ("Petrucci et al."). The Examiner has failed to establish a *prima facie* case of obviousness because the Examiner has not clearly articulated the reasons why the applied references would

allegedly render obvious the claims. Moreover, *Shimomura* and *Petrucelli et al.* do not render obvious the subject matter that is recited in claim 1.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. MPEP § 2142, 8th Ed., Rev. 6 (Sept. 2007).

"A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." MPEP § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. MPEP §2143.01(III) (internal citation omitted). Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP § 2141.02(I) (emphasis in original; internal citations omitted).

Shimomura fails to teach or suggest "judging a somatotype of the body . . . classified on the basis of a correlation between the approximate values as calculated and the body weight," as recited in amended claim 1 (emphasis added). "[T]he approximate values" refer to the "at least one of approximate values of bone weight, water weight, and muscular weight" recited in claim 1 (emphasis added).

Shimomura discloses, "a body type determination apparatus 10 comprises a bi[o]electric impedance meter 20 equipped with a weight scale and a control box 40" (col. 3, lines 56-58). "[T]he bioelectric impedance meter 20 equipped with the weight scale comprises: the constant current feeding electrodes 21a and 21b; ... the voltage measuring electrodes 22a and 22b; a voltage measuring circuit 24 functioning as an impedance measurement device for measuring a voltage between said voltage measuring electrodes 22a and 22b; [and] a body weight measuring unit 25 functioning as a body weight measurement device for measuring a body weight of a subject" (col. 4, lines 9-19). "[T]he control box 40 comprises: a data input device 41" (col. 4, lines 21-22). "[T]he apparatus displays a relationship between the BMI and the FMI and/or between the BMI and the LMI as a result of measurement by way of a graph and/or illustration" (col. 3, lines 42-45).

The Examiner cites Figures 5-7 of *Shimomura* for an alleged teaching of "judging the somatotypes of the body, which are classified on the basis of correlations between approximate values as calculated and body weight" (Office Action, page 5, paragraph 1). However, the Examiner fails to clearly articulate where a "correlation between" "at least one of approximate values of bone weight, water weight, and muscular weight" "and the body weight," as recited in claim 1 (emphasis added), is allegedly present among the parameters shown in Figures 5-7 of *Shimomura*. *Shimomura* discloses a relationship with a different combination of parameters than the values recited in claim 1.

Petrucelli et al. does not make up for the deficiencies of *Shimomura*. *Petrucelli et al.* teaches, "[t]he microprocessor also includes algorithms which operate to calculate a

patient's body fat as identified below from the patient's measured weight" (col. 9, lines 49-51), "the microprocessor may utilize the determined values . . . to calculate lean body mass (LBM)" (*Id.* at lines 53-58), "[f]at mass (FM) may then be calculated" (col. 10, line 7), and "[e]ach of these values may then be displayed to the user via the display unit 122" (col. 10, lines 16-17).

Petrucelli et al. is silent as to "judging a somatotype of the body . . . classified on the basis of a correlation between the approximate values as calculated and the body weight," as recited in claim 1 (emphasis added). The Examiner does not rely on *Petrucelli et al.* for any teaching or suggestion of this element of claim 1.

As explained above, the Examiner has failed to establish a *prima facie* case of obviousness because the Examiner has not clearly articulated the reasons why the applied references would allegedly render obvious the claims. Moreover, *Shimomura* and *Petrucelli et al.* do not render obvious the equipment that is recited in claim 1. Accordingly, this rejection of claim 1 and claims 2, 3, 5, and 6, which depend therefrom, over *Shimomura* and *Petrucelli et al.*, should be withdrawn.

CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-3, 5, and 6 in condition for allowance.

Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Furthermore, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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